



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,399	09/16/2002	Phillip Mackie	2625-1-001	1754

7590

06/15/2006

Klauber & Jackson  
Continental Plaza  
411 Hackensack Avenue  
Hackensack, NJ 07601

EXAMINER
----------

NAKARANI, DHIRAJLAL S

ART UNIT	PAPER NUMBER
----------	--------------

1773

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,399

Applicant(s)

MACKIE ET AL.

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/2006.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 15, 2006 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-8, 10-12, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, lines 11-12, the phrase "monolayer of the polymeric material" renders claim confusing based on applicants arguments at page 3, paragraph 3, relating to Figure 3 given on page 14 of the Amendment and Response filed May 15, 2006. It is not clear whether applicants are trying to claim monomolecular layer as shown in the Figure 3 or trying to claim monolayer of the polymeric material. The Figure 3 shows monomolecular layer of amino silane not the polymeric material. Clarification and/or correction requested.

Art Unit: 1773

4. Claims 1-8, 10-12, 16 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-25 of copending Application No. 10/826,143. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claimed identical method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-8, 11, 12, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Feder (U. S. Patent 5,140,061) for the reasons of record set forth in paragraph 6 of the Office Action mailed March 30, 2004 (Paper No. 20040317). In addition the silicone elastomer coating produced by reaction of an alpha - omega - (dihydroxy) polydiorganosiloxane and an amino silane and/or amidosilane on the substrate surface by deep coating method (col. 8, lines 53-62) deemed to be monolayer of polymeric material and have either -NH<sub>2</sub> groups or -NH-groups unless shown otherwise. Further the silicone -elastomer deemed to have residual hydroxyl groups from either from alpha-omega -(dihydroxy) polydiorganosiloxane and/or from hydrolyzed aminosilane and/or amidosilane unless shown otherwise. Feder also disclose adhesion of the coating material to glass substrate such that the coating (ribbon) cannot be detached from the substrate (Examples and Table, specifically col. 9, lines 50-57).

6. Receipt of Information Disclosure Statement filed April 19, 2006 is acknowledged and has been made of record.

7. Applicant's arguments filed May 15, 2006 have been fully considered but they are not persuasive. In reference to rejection of claims 1-8, 11, 12, 16 and 17 under 35 U.S.C. 102(b) as being anticipated by Feder (U. S. Patent 5,140,061), that Feder's cured coating has NH groups as shown in Figure 2 of the response would not react with TCA. Applicants further state that the present invention first functional group capable of reacting with TCA and the second group capable reacting with the substrate surface and points to Figures 3 and 4 of the response and Examples 1-5.

These arguments are unpersuasive because the invention as claimed is not limited to the coatings of Example 1-5. Furthermore there is no showing that Feder's coating composition having hydroxyl groups and amino or amido groups during curing on the substrate surface does not react with substrate and after curing there is no left over said reactive groups to react with TCA. The Examples 2-4 of present disclosure appears to show monomolecular silane layer on the substrate surface. The invention as claimed does not require monomolecular layer as argued.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

Art Unit: 1773

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



**D. S. Nakarani**  
**Primary Examiner**  
**Art Unit 1773**

DSN  
May 30, 2006.